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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,135	11/12/2003	Wayne T. Holcombe	P1978US	6222

54384 7590 03/29/2007  
FRANCISSSEN PATENT LAW, P.C.  
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SUITE # 1320  
CHICAGO, IL 60604

EXAMINER
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DAO, MINH D

ART UNIT	PAPER NUMBER
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2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,135	<b>Applicant(s)</b> HOLCOMBE ET AL.	
	<b>Examiner</b> MINH D. DAO	<b>Art Unit</b> 2618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 7-11,21,12-24,22-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-6,15-20) in the reply filed on 01/12/07 is acknowledged. The traversal is on the ground(s) that distinct inventions are made without burden on examiner. This is not found persuasive because distinct or multiple inventions application always creates burden on examiner regarding to search for existing references to determine if the application is patentable.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1,5,6,15,18 are rejected under 35 U.S.C. 102(e) as being anticipated by Lucidarme et al. (US 6,615,035).

Regarding claim 1, Lucidarme teaches a transmitter circuit (see fig. 1, items 4), the transmitter circuit comprising:

a storage section for storing operating parameters (see fig. 1, Memory 13); a transmitter section configured to transmit a signal having characteristics determined by the operating parameters (see fig. 1, air interface 8 and antenna 9); an external data store (see fig. 1, PSTN 6); and an internal controller (see fig. 1, control 12), the internal controller being configured to operate the transmitter section in accordance with the operating parameters, where the internal controller senses a state of an input terminal to determine whether an external controller is present or not present, where the internal controller operates to receive and store the operating parameters from the external controller when the external controller is present, and where the internal controller operates to access the external data store to obtain the operating parameters when the external controller is not present and store the operating parameters in the storage section (see col. 3, line 45 to col. 5, line 19). In this case, the determination whether a SIM card has been inserted in the reader 16 or not, and the alternative way of

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downloading operating parameters from the PSTN of Lucidarme reads on "the sensing whether or not the external controller is present" of the present invention.

Regarding claim 5, Lucidarme teaches the transmitter circuit is configured to interface with the external data store using a pre-determined interface (see fig. 1, connection to PSTN by way of interface 5).

Regarding claim 6, Lucidarme teaches the pre-determined interface is a serial interface (see fig. 1, connection to PSTN by way of interface 5).

Regarding claim 15, the rejection of claim 1 is herein incorporated. In addition, the determination by the controller 12 whether a SIM card has been inserted in the reader 16 or not reads on the "sensing a logical state of a first predetermined terminal of the transmitter to determine whether the transmitter is to operate in a stand-alone mode of operation" of the present invention.

Regarding claim 18, the claim includes limitations as that of claim 1, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 1.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4,16,17,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucidarme et al. (US 6,615,035) in view of Tatebayashi et al. (US 6,859,535).

Regarding claim 2, Lucidarme, as mentioned above, teaches the limitations of claim 1 regarding receiving operating parameters from an external party. However, Lucidarme fails to teach receiving a first input signal corresponding to a first event and, responsive thereto, access a first portion of the external data store. Tatebayashi, in an analogous art, teaches a memory card reader that reads a partial contents of an encrypted content sent by a storing unit by a command (see fig. 4-6; col. 12, lines 3-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the above teaching of Tatebayashi to Lucidarme so that the combined system to only obtain the required or needed operating parameters in order to save time and space in the memory to store the obtained information.

Regarding claim 3, the claim includes limitations as that of claim 2, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 2.

Regarding claim 4, the combination of Lucidarme and Tatebayashi teaches the first event corresponds to a user input (see Lucidarme, col. 3, line 45 to col. 5, line 19).

Regarding claims 16,19, the claims include limitations as that of claim 2, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 2.

Regarding claims 17,20, the claims include limitations as that of claim 3, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 3.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D. DAO whose telephone number is 571-272-7851. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW ANDERSON can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Minh Dao *MD*  
AU 2618  
March 23, 2007



Matthew Anderson  
Supervisor AU 2618